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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,005	06/19/2001	Mark C. Embrey	0233MH-20778C	6749
7590	12/02/2004		EXAMINER	
Melvin A. Hunn, Esq. HILL & HUNN LLP Suite 1440 201 Main Street Fort Worth, TX 76102			BORLINGHAUS, JASON M	
			ART UNIT	PAPER NUMBER
			3628	
DATE MAILED: 12/02/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/884,005	EMBREY, MARK C.
	<b>Examiner</b>	<b>Art Unit</b>
	Jason M. Borlinghaus	3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 20 August 2001.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 73-85 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 73-85 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 20 August 2001 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

Claims 1 – 72 were cancelled by amendment.

### ***Claim Objections***

Claims 77 – 79 are objected to because of the following informalities: the phrase “a payment service provider.” Claims 77 – 79 cannot be clearly understood as it is unclear whether the applicant is referring to the previously mentioned “said service provider” or another, as yet unmentioned, entity called “a payment service provider.” Examiner suggests that applicant replace the phrase “a payment service provider” with the phrase “said service provider” for the purpose of improving language clarity.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 73 – 85 are rejected under 35 U.S.C. 102(b) as being anticipated by Hilt (U.S. Patent 5,465,206).

Regarding Claim 73, Hilt discloses a method of delivering payment information from a plurality of payor entities (consumers) to a plurality of payee entities (billers) through the coordinated operation of the payor entities and a service provider (payment network) comprising the method steps of:

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- utilizing at least one data processing system (computers, computer networks, and telecommunications equipment – see col. 18, lines 24 – 27) to sort and format payment information from said plurality of payor entities (consumers) concerning a plurality of payment obligations. (“To authorize a remittance, a consumer transmits to its bank (a participating bank) a bill pay order indicating a payment date, a payment amount, the consumer's account number with the biller, a source of funds and the biller's biller identification number, either directly or by reference to static data containing those data elements.” – see abstract);
- communicating said payment information to said service provider. (“Bank C then submits a payment message to payment network...” – see abstract);
- utilizing at least one data processing system (computer) under control of said service provider (payment network) to consolidate said payment information concerning said plurality of payment obligations from said plurality of payor entities (consumers) in accordance with at least one predetermined consolidation criterion. (Hilt discloses that the payment network “assigns the biller reference number” (see abstract) and maintains “biller files, which has one record per BRN,” (see col. 15, lines 2 – 6) indicating that Hilt does group payment information based upon payee (biller) identity);

- directing payments to said plurality of payees (billers) in order to satisfy said plurality of payment obligations; (“...the payment network, which assigns the biller reference number, forwards the payment message to the biller’s bank.” – see abstract).
- directing consolidated payment information (A/R data), independently of said payments, from said service provider (payment network) to said plurality of payees (billers). (“Payment message is passed on to Bank B, but the A/R data (date, amount, C-B account #) from message is passed directly to biller B, on behalf of Bank B, and is used to update biller B’s G/L database.” – see col. 18, lines 8 – 11 and figure 8).

Regarding Claim 74, Hilt discloses a method of delivering payment information wherein said at least one consolidation criterion comprises grouping said payment information by payee (biller) identity. (Hilt discloses that the payment network “assigns the biller reference number” (see abstract) and maintains “biller files, which has one record per BRN,” (see col. 15, lines 2 – 6) indicating that Hilt does group information based upon payee (biller) identity.)

Regarding Claim 75, Hilt discloses a method of delivering payment information wherein said step of directing payments comprises:

- initiating electronic funds transfers from said plurality of payor entities (consumers) to said plurality of payee entities (billers). (“An electronic funds transfer network for transferring funds from a consumer account to a biller account...” – see Claim 1).

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Regarding Claim 76, Hilt discloses a method of delivering payment information wherein said step of directing payments comprises:

- directing negotiable instruments from said plurality of payor entities (consumers) to said plurality of payee entities (billers). ("An electronic funds transfer network for transferring funds from a consumer account to a biller account..." – see Claim 1).

Regarding Claim 77, Hilt discloses a method of delivering payment information wherein said step of directing payments comprises:

- utilizing said service provider (payment network) to direct negotiable instruments from said plurality of payor entities (consumers) to said plurality of payee entities (billers) on behalf of said plurality of payor entities (consumers). ("An electronic payment network for transferring funds from a consumer to a biller to pay a bill owed by the consumer to the biller..." – see Claim 30).

Regarding Claim 78, Hilt discloses a method of delivering payment information wherein said step of directing payments comprises:

- utilizing said service provider (payment network) to consolidate payment obligations and to direct negotiable instruments from said plurality of payor entities (consumers) to said plurality of payee entities (billers) on behalf of said plurality of payor entities (consumers). ("An electronic payment network for transferring funds from a consumer to a biller to pay a bill owed by the consumer to the biller..." - see Claim 30).

Regarding Claim 79, Hilt discloses a method of delivering payment information wherein said step of directing payments comprises:

- utilizing a payment service provider (payment network) to initiate electronic funds transfers to said plurality of payee entities (billers) on behalf of said plurality of payor entities (consumers). (“An electronic payment network for transferring funds from a consumer to a biller to pay a bill owed by the consumer to the biller...” – see Claim 30).

Regarding Claim 80, Hilt discloses a method of delivering payment information wherein said step of communicating comprises:

- communicating electronically (“data communication channel from one point to another” – see col. 4, lines 13 – 15) said payment information to said service provider (payment network) (see figure 8).

Regarding Claim 81, Hilt discloses a method of delivering payment information wherein said step of directing consolidated payment information comprises:

- communicating electronically (“data communication channel from one point to another” – see col. 4, lines 13 – 15) said consolidated payment information (A/R data – see col. 18, lines 8 – 11), independently of said payments, from said service provider (payment network) to said plurality of payees (billers) (see figure 8).

Regarding Claim 82, Hilt discloses a method of delivering payment information wherein said step of utilizing at least one data processing system to sort and format includes:

- utilizing at least one data processing system (computer) to sort said payment information by at least one of payee (biller) identity. (Hilt discloses that the payment network “assigns the biller reference number” (see abstract) and maintains “biller files, which has one record per BRN,” (see col. 15, lines 2 – 6) indicating that Hilt does sort payment information based upon payee (biller) identity).

Regarding Claim 83, Hilt discloses a method of delivering payment information wherein said step of utilizing said at least one data processing system to sort and format includes:

- utilizing at least one data processing system (computer) to sort said payment information by performing information by at least one of payee (biller) identity. (Hilt discloses that the payment network “assigns the biller reference number” (see abstract) and maintains “biller files, which has one record per BRN,” (see col. 15, lines 2 – 6) indicating that Hilt does sort payment information based upon payee (biller) identity); and
- utilizing at least one data processing system (computer) to format said payment information by performing at least one of arranging said payment information. (Hilt discloses that the payment network “assigns the biller reference number” (see abstract) and maintains “biller files, which has one record per BRN,” (see col. 15, lines 2 – 6) indicating that Hilt does arrange payment information based upon payee (biller) identity); and

Regarding Claim 84, Holt discloses a method of delivering payment information wherein said step of directing consolidated payment information comprises:

- communicating electronically consolidated ("data communication channel from one point to another" – see col. 4, lines 13 – 15) payment information (A/R data – see col. 18, lines 8 – 11), independently of said payments, from said service provider (payment network) to said plurality of payees (billers), without requiring active interaction between said service provider (payment network) and said plurality of payees ("...the process is highly automated and simple for the biller." – see col. 19, lines 45 – 46).

Regarding Claim 85, Holt discloses a method of delivering payment wherein said step of directing consolidated payment information comprises:

- communicating printed consolidated payment information (A/R data – see col. 18, lines 8 – 11), independently of said payments, from said service provider (payment network) to said plurality of payees (billers), without requiring active interaction between said service provider and said plurality of payees. ("...the process is highly automated and simple for the biller." – see col. 19, lines 45 – 46). (Hilt discloses "...a physical link for paper flow..." (see col. 4, lines 12 – 15) and "Material' refers to documents and/or information, whether paper-based ('postal mail'), electronic (e-mail, messages, packets, etc.), or other transfer medium" (see col. 4, lines 18 – 20) indicating that payment information could be communicated in printed format.)

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (703) 308-9552. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (703) 308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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